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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,835	08/25/2000	Scott Koenig	469201-493	4179

7590

06/03/2003

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EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 06/03/2003

*Lo*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/645,835

Applicant(s)

KEONING ET AL.

Examiner

Chih-Min Kam

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-30 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) 9-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-30 and 37 is/are allowed.
- 6) ☒ Claim(s) 33-35 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of the Claims*

1. Claims 9-30 and 33-37 are pending.

Applicants' amendment filed on March 28, 2003 (Paper No. 18) is acknowledged, and applicants' response has been entered fully considered. Claims 9-24 are non-elected inventions and remain withdrawn from consideration. Claims 25, 28 and 33 have been amended, thus claims 25-30 and 33-37 are examined.

2. The references listed in Information Disclosure Statement have been considered, a copy of signed IDS is attached.

### Rejection Withdrawn

#### *Claim Rejections - 35 USC § 112*

3. The previous rejection of claims 25-28 and 33-35 under 35 U.S.C. 112, first paragraph, is withdrawn in view of applicants' amendment to the claim, and applicants' response at pages 4-6 in Paper NO. 18.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Brodeur *et al.* (US 2003/0031682, priority date February 20, 1998).

Brodeur *et al.* teach antigenic polypeptides of group B streptococcus (GBS) such as SEQ ID Nos :15 and 16 (paragraphs 0055 and 0056). The peptide of SEQ ID NO:15 has 95.2% sequence identity to SEQ ID NO:2 and 34% to SEQ ID NO:7; and the peptide of SEQ ID NO:16 has 86.1% sequence identity to SEQ ID NO:2 and 30% to SEQ ID NO:7 (See attached sequence match; claim 33-35). The peptides of SEQ ID Nos :15 and 16 would be expected to binds to an antibody specific for Sp36 because the peptides contain the structural features of the claimed sequence, and because the specification (Example 5) also indicates antiserum raised against the pneumococal Sp36 protein cross react with Sp36 homolog identified from group B streptococcus and thereby indicating conservation of epitopes between the proteins, thus the reference anticipates the claimed invention.

5. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

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6. Claims 33-35 are rejected, and claim 36 is objected. It appears claims 25-30 and 37 are free of art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

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May 31, 2003

*Christopher S. F. Low*  
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